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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,580	07/11/2003	Thomas L. Foster	10922/51	3677

757 7590 03/10/2005

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EXAMINER

SAM, CHARLES H

ART UNIT PAPER NUMBER

3731

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/617,580	Applicant(s) FOSTER ET AL.	
	Examiner Charles H. Sam	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 2,5,6,15-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The word "about" in claims 2,5,6 and 15-17 is vague and renders the claims indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Kusleika et al. 6,773,448. Kusleika discloses a flexible cannula 345 comprising a proximal portion and

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a distal portion having a spiral cut 349 along a longitudinal axis of the cannula 345, wherein the cannula 345 forms a continuum of material.

Regarding claim 8, note column 25, lines 29-44.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 2,5,6,15-19,21,22,24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kusleika et al. 6,773,448. The dimension as recited in the claims is an obvious matter of design choice.

Regarding claims 18,19,21,22 and 24, the device of Kusleika comprises a grasping portion.

Regarding claim 25, see figure 34.

4. Claims 3,4,7,8,12 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kusleika et al. 6,773,448 in view of Li 5,549,636. Kusleika discloses the invention as claimed except for a grasping means at the distal end. However, Li discloses a surgical grasping device comprising a finger means at the distal end of the device. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify Kusleika by including a finger means in view of Li to provide a grasping means for grasping an object.

Regarding claim 27, the device of Kusleika in view of Li is inherently capable of performing the recited method steps.

5. Claims 9 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kusleika et al. 6,773,448 in view of Sirimanne et al. 6,136,014. Kusleika discloses the invention as claimed except for a cutting blade. However, Sirimanne discloses a tissue removing device comprising a cutting blade. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify Kusleika by adding a cutting blade in view of Sirimanne for cutting the tissue.

6. Claims 10,12,13,20 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kusleika et al. 6,773,448 in view of Dretler 4,927,426. Kusleika discloses the invention as claimed except for a laser fiber. However, Dretler discloses a kidney stone capturing device comprising an optical fiber 30 as shown in figures 5 and 6. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify Kusleika by including a laser fiber in view Dretler to provide means for transmitting light.

Regarding claim 13, it is very well known in the art to use stainless steel to make the cannula to prevent rusting.

Regarding claim 28, the modified device of Kusleika in view of Dretler is inherently capable of performing the recited method steps.

7. Claims 11 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kusleika et al. 6,773,448 in view of Dretler 4,927,426 as applied to claims 10,12,20 and 28 above, and further in view of Goodman 4,557,255. Kusleika in view of Dretler

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discloses the invention as claimed except a ureteroscope. However, Goodman discloses as shown in figure 1-6 a ureteroscope 10 having irrigation channels 36,38 and eye piece 44. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to further modify Kusleika by including a ureteroscope for viewing and irrigating the operation site.

Regarding claim 29, the modified Kusleika device is inherently capable of performing the recited method steps.

8. Claims 14 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kusleika et al. 6,773,448 in view of Duc 5,464,408. Kusleika discloses the invention as claimed except for a sheath enclosing. However, Duc discloses an extraction device comprising a central tube 5 and a sheath enclosing 7. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to modify Kusleika by providing a sheath enclosing in view of Duc to provide a guide sheath.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles H. Sam whose telephone number is (571) 272-4703. The examiner can normally be reached on Monday-Thursday.

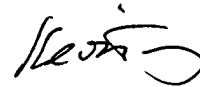
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

chs

chs
February 23, 2005



KEVIN T. TRUONG
PRIMARY EXAMINER